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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,974	07/30/2001	Tanja Ligensa	9515	1210
151 7590 11/14/2003 HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY, NJ 07110			EXAMINER ANDRES, JANET L.	
			ART UNIT 1646	PAPER NUMBER

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,974

Applicant(s)

LIGENSA ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4,6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **RESPONSE TO AMENDMENT**

1. Applicant's amendment filed 7 October 2003 is acknowledged. On entry of the amendment, claims 3, 4, and 6 will be pending and under examination. Upon further consideration, the finality of the previous office action is withdrawn. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

#### ***Claim Rejections Withdrawn***

2. The rejection of claim 10 under 35 U.S.C. 112, first paragraph, is withdrawn in response to Applicant's cancellation of this claim.

#### ***New Grounds of Rejection***

3. Claims 3, 4, and 6 are newly rejected under 35 U.S.C. 112, first paragraph, as lacking enablement commensurate in scope with the claims.

These claims are drawn to methods of detection of "an IGF-1 receptor interacting protein" using SEQ ID NO: 5, a complement, or a sequence that hybridizes to either. There is no limitation either in the claims or in the specification as to what constitutes "an IGF-1 receptor interacting protein", there is no requirement that the complement be full length, and no hybridization conditions are specified. Since the complement could be any length at all, since the hybridizing conditions encompass potentially any DNA molecule, molecules within the scope of the claims could detect virtually any molecule. Since the molecules to be detected are not limited to molecules that would hybridize with SEQ ID NO: 5 or the full-length complement thereof, any target identifiable as an IGF-1 receptor interacting protein, including those known in the prior art and those not enabled by the specification, would be within the scope of the claims. Thus, essentially any molecule could be used to detect any nucleic acid that might be identifiable

as an IGF-1 receptor interacting protein. Similar issues were raised in the rejection of 23 August 2002, which was erroneously withdrawn because Applicant overcame only part of the basis for the rejection. Applicant has argued in the response of 24 February 2003 that hybridization conditions are described. However, no conditions are specifically required. The provision of art-standard techniques does not serve to enable the full scope of the invention, but is rather an invitation to the artisan to experiment to implement the invention as broadly claimed.

NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov](mailto:yvonne.eyler@uspto.gov).

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

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set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.

November 13, 2003



JANET ANDRES  
PATENT EXAMINER